

REMARKS

Upon entry of the present amendments, claims 1-8, 11-18, 23, 24, 28, 32-34, 36-38, 40, 41, 44-47, 50-52, 68, 69, and 74-83 will be pending. Claims 53-67 are withdrawn and claims 9, 10, 19-22, 25-27, 29-31, 35, 39, 42, 43, 48, 49 and 70-73 are canceled. Applicants reserve the right to pursue the withdrawn and/or canceled subject matter in a subsequent application. Support for amended claims 1 and 68 can be found throughout the application and, *inter alia*, in original claims 1, 43, and/or 68. Support for new claims 74-83 can be found throughout the application and, *inter alia*, in original claims 19-22, 25-27, 35, 39, and/or 42. The above-described amendments do not introduce any new matter into the present application.

Withdraw of the Previous Rejections/Objections

Applicants appreciate the Examiner's withdrawal of all previous rejections/objections.

Allowable Subject Matter

Applicants appreciate the Examiner's recognition that claim 43 is allowable.

Claim Rejections – 35 U.S.C. § 112

Claims 1-8, 11-18, 20, 23-25, 28, 32-34, 36-38, 40, 41, 43-48, and 50-52 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner offered several suggestions for addressing the alleged indefiniteness of these claims:

- a) Claim 1, line 5: -- microfluidic application -- should be inserted before "chip";
- b) Claim 1, line 7: Does "built-in in" mean -- built into --?

c) Claim 45: Applicants stated they deleted limitation (b)(viii) from claim 1 in order to overcome Weetall (see page 15 of the Amendment of March 23, 2005); however claim 45 retains this limitation. Thus, claim 45 is indefinite because it is not clear whether Applicants inadvertently forgot to cancel claim 45.

Applicants respectfully traverse these rejections. Nevertheless, Applicants appreciate the Examiner's suggestions and, in order to advance the prosecution, have made several amendments to address the Examiner's concerns.

Applicants have inserted "microfluidic application" before "chip" in claim 1, line 6.

In claim 1, line 7, "built-in in" has been changed to "built into or on". A similar amendment has been made to claim 68. Support for these amendments can be found throughout the application. Applicants particularly direct the Examiner to p. 44 of the original application which states that "[t]ypically, for the case of manipulation force being acoustic forces, the *built-in* structures are the piezoelectric elements or structures that are incorporated *on* a chip." (emphasis added)

Applicants have retained claim 45. Claim 45 is dependent on claim 1, which now incorporates the limitations of claim 43 (now canceled) which the Examiner had indicated to be allowable. Claim 45 serves to further limit claim 1 by requiring the moiety to be "not directly manipulatable by an optical radiation force" in addition to being "not directly manipulatable by an acoustic force" (see claim 1). Similarly, claim 45 serves to further limit claim 1 by requiring the moiety-binding partner complex to be "manipulated by an optical radiation force" in addition to being "manipulated by an acoustic force" (see claim 1).

The Applicants respectfully submit that all rejections based on 35 U.S.C. § 112 are now overcome by the above remarks and/or amendments and must be withdrawn.

Rejections under 35 U.S.C. §§ 102-103

Claims 1-8, 12-18, 23-25, 28, 32, 40, 41, 48, 50-52, 68, and 69 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Parton et al. (US 5,993,631) ("Parton").

Claims 45, 68, and 69 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Weetall et al. (US 5,620,857).

Claims 11, 46, and 47 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Parton et al. (US 5,993,631) ("Parton") in view of Weetall (US 5,620,857) ("Weetall").

Claims 33 and 36 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Parton et al. (US 5,993,631) ("Parton").

Claim 34 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Parton et al. (US 5,993,631) ("Parton") in view of Hawkins (WO 96/09379 A1) ("Hawkins"), CAPLUS abstract of Ma et al. ("Synthesis of uniform microspheres with higher content of 2-hydroxylmethacrylate by employing SPG (Shirasu porous glass) emulsification technique followed by swelling process of droplets," Journal of Applied Polymer Science (1997), 66(7), 1325-1341) ("Ma"), CAPLUS abstract of Chen et al. (CN 1145410 A), and CAPLSU [sic] abstract of Yang et al. ("New, porous microsphere of bisphenol A epoxy resin," Gaofenzi Xuebao (1997), (1), 119-120) ("Yang").

Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Parton et al. (US 5,993,631) ("Parton") in view of Hawkins (WO 96/09379 A1) ("Hawkins"), CAPLUS abstract of Yuan et al. ("Protein-loaded poly (ϵ -caprolactone) microparticles. I. Optimization of the preparation by (water-in-oil)-in water emulsion solvent evaporation," journal of Encapsulation 91999), 16(5), 587-599) ("Yuan"), CAPLUS abstract of Rojas et al. ("A polysorbate-based nonionic surfactant can modulate loading and release of β -lactoglobulin entrapped in multiphase poly(DL-lactide-co-glycolide) microspheres," Pharmaceutical Research (1999), 16(2),

255-260) ("Rojas"), Hernandez et al. ("Influence of shaking and surfactants on the release of BSA from PLGA microspheres," European journal of Drug Metabolism and Pharmacokinetics (1998), 23(2), 92-96) ("Hernandez"), and Shen ("Preparation, characterization and application of magnetic microsphere," Huaxue tongbao (1997), (9), 55-57) ("Shen").

Claims 1-7, 12, 44, 68, and 69 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Fuchs et al. (US 5,948,231) ("Fuchs").

Claims 72 and 73 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Weetall et al. (US 5,620,857) in view of Hawkins (WO 96/09379 A1) ("Hawkins"), CAPLUS abstract of Ma et al. ("Synthesis of uniform microspheres with higher content of 2-hydroxylmethacrylate by employing SPG (Shirasu porous glass) emulsification technique followed by swelling process of droplets," Journal of Applied Polymer Science (1997), 66(7), 1325-1341) ("Ma"), CAPLUS abstract of Chen et al. (CN 1145410 A), and CAPLSU [sic] abstract of Yang et al. ("New, porous microsphere of bisphenol A epoxy resin," Gaofenzi Xuebao (1997), (1), 119-120) ("Yang").

Applicants respectfully traverse these rejections. However, in order to advance the prosecution, Applicants have amended independent claims 1 and 68 by incorporating the limitations of claim 43 (now canceled), which the Examiner had indicated to be allowable. Consequently, claims 1 and 68, as well as all claims dependent on them, are now patentable over the prior art cited by the Examiner.

Claims 72 and 73 have been canceled.

New claims 74, and 81-83 are patentable because they are dependent on claim 1 and serve to further limit claim 1. New claims 75-80 are patentable because they are dependent on new claim 74 and serve to further limit new claim 74.

Applicants respectfully submit that the remarks and/or amendments above overcome all anticipation and obviousness rejections under 35 U.S.C. §§ 102-103 and that those rejections must be withdrawn.

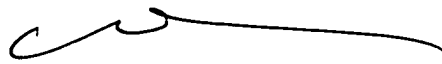
Conclusions

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 471842000100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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